

**Amendments to the Drawings**

The attached sheet of drawings includes changes to Fig. 1. This sheet replaces the original sheet including Fig. 1.

Attachment:      Replacement Sheet  
                        Annotated Marked-up Drawings

**REMARKS/ARGUMENTS**

Applicants respectfully request further examination and reconsideration in view of the arguments set forth fully below. Claims 1-42 were previously pending in this application. Claims 1-42 have been rejected. By the above amendments, Claims 1, 15, 22, 36, and 38 have been amended, Claims 2-14 and 23-35 have been canceled, and Claims 43-46 have been added. No new matter has been added. Accordingly, Claims 1, 15-22, and 36-46 are now pending in this application.

**Title**

The Office Action states that the title of the invention is not descriptive. The title has been amended accordingly.

**Related Applications**

The Office Action states that the "Related Applications" section must be moved prior to the "Background of the Invention" section. The specification has been amended accordingly.

**Specification**

The Office Action states that the applicants should review the application for correct correlation between reference numerals in the textual portion of the specification and the drawings. The specification has been amended accordingly.

**Drawings**

The Office Action states that the applicants should review the application for correct correlation between reference numerals in the textual portion of the specification and the drawings. Figure 1 of the drawings has been amended accordingly.

**Rejections under 35 U.S.C. § 102**

Within the Office Action, Claims 1-42 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,785,712 to Hogan et al. (hereinafter "Hogan"). The applicants respectfully disagree with this rejection.

Hogan teaches an electronic mail delivery and transmission system that has been developed for an aircraft environment. Hogan's system has an airborne server aboard the aircraft and a ground server, and the two servers are connected by an air-to-ground data link. [Hogan, col. 1, lines 26-31] Hogan teaches a method for sending electronic mail which separates at least one attachment from a text portion in an electronic mail message. [Hogan, col. 5, lines 54-62] Hogan further teaches that the ground server determines the size of any attachment accompanying an email, strips the attachment before sending it to the airborne server, generates a URL to be generated and inserted at the beginning of the email message, and converts the attachment to a web page that can be accessed by the recipient through a web browser program. [Hogan, col. 4, line 57-col. 5, line 8]

Hogan does not teach the use of any other non-email methods of delivering the email attachment besides the use of a web page. Because only one possible method of delivery of the email attachment is taught, Hogan does not teach the probing of the recipient, recipient gateway, or application service provider to select the preferred method of delivery of the email attachment.

In contrast to Hogan, the present invention teaches the selection and use of an out-of-band technique different from the mode normally used to transmit email. Specifically, the present invention requires that email data and attachments may be transmitted using a file transfer protocol (FTP) or hypertext transfer protocol (HTTP). [Specification, page 4, lines 5-7 and page 7, lines 10-13] Moreover, the present invention also teaches that the sender or sender gateway may send a probing signal to the recipient, recipient gateway, or application service provider to determine the best method of delivery. [Specification, page 15, lines 1-8] Depending upon the results of the probe, a preferred method for delivery of the email attachment is selected.

Hogan teaches the use of two types of email protocols, POP and STMP. However POP is a standard protocol by which email client software *retrieves* mail

messages from an email server, [Hogan, col. 6, line 66 – col. 7, line1], while SMTP is the standard protocol used to *send* email. [Hogan, col 7, line 14] Neither of these protocols is selected by the recipient or recipient gateway; they are fixed protocols pre-established by the airborne electronic mail delivery system. Thus, the email protocol is distinguishable from a "preferred method for delivery" of email as used in the present invention. The latter refers to a non-email transmission method, such as FTP or HTTP. [Specification, page 4, lines 5-7 and 16-18]

The amended independent Claim 1 is directed to a method for sending electronic mail comprising separating at least one attachment from a text portion in an electronic mail message such that a link is created between said at least one attachment and said text portion, delivering said at least one attachment at a time other than when said text portion is delivered, using a non-email transfer protocol to deliver said at least one attachment, *selecting a preferred method for delivery*, and making said at least one attachment available from said text portion. As discussed above, Hogan does not teach probing the recipient or recipient gateway to select a preferred method for delivery of the email attachment. For at least these reasons, the independent Claim 1 is allowable over the teachings of Hogan.

Claim 15 is dependent on the independent Claim 1. As described above, the independent Claim 1 is allowable over the teachings of Hogan. Accordingly, Claim 15 is also allowable as being dependent on an allowable claim. Moreover, claim 15 requires that the sender or sender gateway send a probing signal to determine a preferred format in which to transmit the email attachment. [For background, see also Specification, page 15, lines 5-6] Depending upon the results of the probe, a preferred format for delivery of the email attachment is selected. Hogan does not teach probing for a preferred delivery format. For at least these reasons, the dependent Claim 15 is allowable.

Claim 43 is dependent on the independent Claim 1. As described above, the independent Claim 1 is allowable over the teachings of Hogan. Accordingly, Claim 43 is also allowable as being dependent on an allowable claim. Moreover, Claim 43 specifically requires that the sender or sender gateway send a probing signal to determine a preferred caching location in which to cache the email attachment. [For

background, see Specification, page 15, lines 3-5] Depending upon the results of the probe, a preferred caching location for the email attachment is selected. Hogan does not teach probing for a preferred caching location. For at least these reasons, the dependent Claim 43 is allowable.

Claim 44 is dependent on the independent Claim 1. As described above, the independent Claim 1 is allowable over the teachings of Hogan. Accordingly, Claim 44 is also allowable as being dependent on an allowable claim. Moreover, Claim 44 specifically requires that the sender or sender gateway send a probing signal to determine a preferred file transfer protocol to use for transmitting the email attachment. [For background, see Specification, page 15, lines 5-6] Depending upon the results of the probe, a preferred file transfer protocol for the email attachment is selected. Hogan does not teach probing for a preferred file transfer protocol. For at least these reasons, the dependent Claim 44 is allowable.

Claim 16 – 21 depend either directly from Claim 1 are therefore submitted as allowable as being dependent on an allowable claim. Each of these claims adds limitations further distinguishing over the cited art.

The amended independent Claim 22 is directed to an apparatus for sending electronic mail comprising means for separating at least one attachment from a text portion in an electronic mail message such that a link is created between said at least one attachment and said text portion, means for delivering said at least one attachment at a time other than when said text portion is delivered, means for using a non-email transfer protocol to deliver said at least one attachment, *means for selecting a preferred method for delivery*, and means for making said at least one attachment available from said text portion. As discussed above, Hogan does not teach probing the recipient or recipient gateway to select a preferred method for delivery of the email attachment. For at least these reasons, the independent Claim 22 is allowable over the teachings of Hogan.

Claims 36 – 46 depend either directly or indirectly on Claim 22, and are therefore submitted as allowable for being dependent upon an allowable claim. Each of these claims adds limitations further distinguishing over the prior art.

No new subject matter has been added by way of the above amendments. For the reasons given above, the applicants respectfully submit that the Claims 1, 15-22, and 36-46 are now in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, he is encouraged to call the undersigned at (650) 838-4441 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,  
Perkins Coie LLP



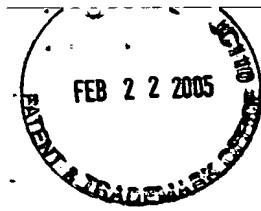
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Title: Asynchronous Out of Band Delivery of Embedded Media Objects  
Inventor: Yen  
Docket: 196.1004.01  
Sheet: 1 of 2

Sheet 1 of 2

Annotated Marked-up Drawings  
APPLICATION SERVICE PROVIDER (ASP) 160

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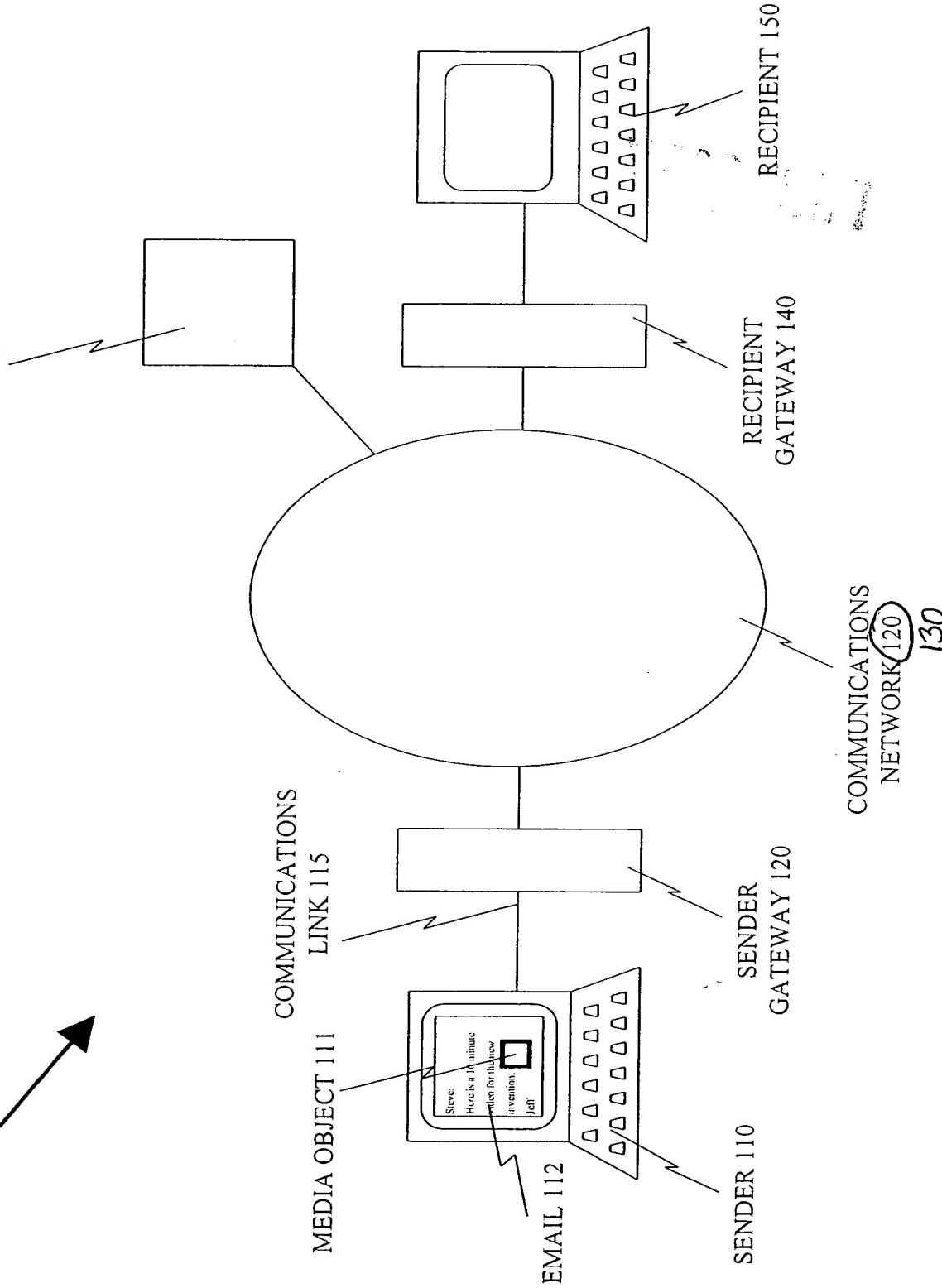


Fig. 1/2